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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/486,069 06/07/95 ENGELHARDT

D ENZ-5 (D8) (C2)

028170 HM12/1009
ENZO DIAGNOSTICS, INC.
C/O ENZO BIOCHEM INC.
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EXAMINER

MARSCHEL, A

| | |
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| ART UNIT | PAPER NUMBER |
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1631

DATE MAILED:

10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

| | |
|-------------------------------|-----------------------------------|
| Application No. 08/486,069 | Applicant(s) Englehardt et al. |
| Examiner Ardin Marschel | Art Unit 1631 |

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on dates listed in attachment

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) see attached list is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) Claim(s) see attached list is/are allowed.

6) Claim(s) see attached list is/are rejected.

7) Claim(s) see attached list is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8 sheets 20) Other:

Claims lists for 08/486,069 as of October 5, 2001:

Pending claims are 569-1738.

Claims 569-1297, 1411-1581, 1700-1738 are allowed

Claims 1298-1304, 1306, 1320, 1323-1333, 1338-1340, 1345-1355, 1358, 1359, 1373, 1383, 1388-1392, 1394, 1396, 1398-1400, 1403, 1406, 1407, 1582, 1583, 1585, 1593, 1596-1599, 1601, 1602, 1604-1619, 1621-1637, 1639, 1641, 1644-1651, 1653, 1656, 1682, 1686-1688, 1692, and 1694-1699 are rejected.

Claims 1305, 1307-1319, 1321, 1322, 1334-1337, 1341-1344, 1356, 1357, 1360-1372, 1374-1382, 1384-1387, 1393, 1395, 1397, 1401, 1402, 1404, 1405, 1408-1410, 1584, 1586-1592, 1594, 1595, 1599, 1600, 1603, 1620, 1638, 1640, 1642, 1643, 1652, 1654, 1655, 1657-1681, 1683-1685, 1689-1691, and 1693 are objected to.

Applicants' arguments and amendments; filed 3/9/01, 3/12/01, 3/21/01, 5/28/01, 6/7/01, 6/19/01, 7/12/01, 7/13/01, and 7/14/01; have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. They constitute the complete set presently being applied to the instant application.

Claim 1593 is rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1593 there is a lack of antecedent basis for the phrase "said living organism". Also, claim 1593 depends from claim 1592 which is limited to human practice whereas claim 1593 confusingly is broader.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1298-1304, 1306, 1320, 1323-1333, 1338-1340, 1345-1355, 1358, 1373, 1383, 1388-1392, 1394, 1396, 1398-1400, 1403, 1406, 1407, 1582, 1583, 1585, 1596-1599, 1601, 1602, 1604-1619, 1621-1637, 1639, 1641, 1644-1651, 1653, 1656, 1682, 1686-1688, 1692, 1694, 1695, and 1697-1699 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Langer et al. (PNAS 78:6633[1981]).

On page 6636 in Figure 3 with the associated discussion the detection of biotin base labeled DNA via hybridization is disclosed which anticipates the above listed instant claims.

Claims 1298-1304, 1306, 1320, 1324-1333, 1338-1340, 1345, 1348, 1349, 1358, 1359, 1373, 1388-1392, 1394, 1398-1400, 1403, 1406, 1582, 1583, 1585, 1596-1599, 1601, 1602, 1604-1619, 1621-1624, 1628, 1631, 1632, 1639, 1644, 1686-1688, 1694-1697, and 1699 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Dale et al. (Biochemistry 14(11):2458[1975]).

On page 2459 in Figure 1 with the associated discussion the detection of mercurated base labeled DNA via hybridization is disclosed which anticipates the above listed instant claims.

Enclosed are several pages of PTO Form 1449. Several citations are lined through thereon because they are in Japanese which cannot be considered by the examiner due to this different language and no English translation has been supplied.

The disclosure is objected to because of the following informalities:

In claim 1599 the word "nuceotide" appears to be misspelled.

Appropriate correction is required.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 305-3014 or (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

October 5, 2001

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER